UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,876	01/10/2002	George Chanos	CHANOS.001CP1	7701

20995 7590 04/12/2007	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP	JANVIER, JEAN D	
2040 MAIN STREET		
FOURTEENTH FLOOR	ART UNIT	PAPER NUMBER
IRVINE, CA 92614	3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/12/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/12/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
Office Action Summary	10/043,876	CHANOS ET AL.
	Examiner	**Art Unit**	
	Jean Janvier	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-23* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-23* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claim(s) *1-23* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Specification

The title of the invention, under 37 CFR 1.72, should not exceed 500 characters and should be brief and technically accurate.

Status of the claims

Claims 1-23 are currently pending in the Application. Claims 1-20 were elected, without traverse, for prosecution after a restriction requirement and claims 21-23 were withdrawn from further consideration. Applicant is herein required to cancel withdrawn claims 21-23 \in a future correspondence.

General Comments

Regarding claims 2 and 16, in the limitation "wherein the e-mail address entered comprises one or more e-mail addresses of one or more acquaintances", it appears that the acquaintances' e-mails were not used to perform any meaningful task.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler, USP 5,960,409.

As per claims 1, 3-15 and 17-20, Wexler discloses a system and method for providing on-line third party accounting and statistical information is disclosed. **A third party accounting service receives a download request signal, from a client computer, ultimately intended for an advertiser Web site. The download request signal is generated when a user clicks on a banner displayed on a Web page of a frequently visited host Web site (the request signal is a request for more information, such as a special offer, new product release, pricing, etc., from the advertiser).** The banner is published by the frequently visited host Web site for the benefit of the advertiser. The third party receives the download request since, rather than pointing to the advertiser Web site, the banner is configured to point to the third party Web site. The third party Web site maintains a count of all received download request signals generated by clicking on the banner. Since an advertiser banner may be displayed at more than one frequently-visited Web site, the third party Web site further maintains a log containing the address of the frequently visited host Web site that displayed the banner that generated the click, as well as other information provided by the user Web browser. The third party sends a redirect signal to the user Web browser causing it to send a download request to the advertiser Web site. The advertiser Web site then downloads the information originally sought by the user to his Web browser. The third party accumulates and tabulates statistical information including the number of clicks on the

advertiser banner, and data indicative of the effectiveness of the banner-publisher

frequently-visited Web site as an advertising medium. Such information is provided to

the advertiser and/or the banner publisher (Srr abstract).

In general, Wexler discloses an online accounting or auditing system for

identifying an advertisement or banner Ban 1, from an advertiser Ban 1, having an

inherent identifier (GUID or adGUID) associated with a unique referenced point

http://www.genesis.com/puba/ban1 representing a banner advertisement Ban 1 accessible

at a web site or publisher A or Pub A. **Indeed, upon connecting to a global network or**

the Internet, a user using a remote computer can access a publisher's web site (Pub

A) and click on a banner advertisement or Ban 1 from advertiser Ban 1 to finally be

transported to the advertiser's web site where he can receive more information

about an advertised item or even purchase the advertised item. The remote computer

used by the user is identified as the computer that accesses the banner or Ban 1 at Pub A

or publisher's web site and this information along with other information provided by the

user's web browser and the web site address associated with Pub A are used by a third

party to count the number of clicks or impressions on Ban 1 or banner advertisement at

Pub A, compute other statistical report and measure the effectiveness of the system. Here,

the dynamic IP address related to the user's remote computer during the connection to the

Internet can be used as an ID or second GUID (userGUID) to identify the remote

computer accessing the banner advertisement or Ban 1 at Pub A or an inherent logging

indicium associated with the user, such as logging name and/or password or any other

code, as commonly used in the art to help identify a user or his computer accessing an

information server or web server on a network such as the Internet. **As appropriate, the**

third party accounting and statistical service 13 can define or record a user's click

or impression or interaction on an advertisement or Ban 1 each time the

advertisement or any other advertisement is served to the user connecting to a

publisher's web site wherein the number of clicks is counted in other to measure the

effectiveness of the system. It is further contemplated here that an identification or third

identifier GUID (impGUID) or any marker can be used by the third party accounting and

statistical service 13 to register that, for example, Ban 1 receives a click from a particular

remote computer used by a user, with a specific logging indicium, who accesses a web

site with a given marker or indicium or URL address. Furthermore, these identifiers or

markers or identifications or indicia or first GUID, second GUID and third GUID are

internal operations handled by software and do not directly affect the process or system

by which an advertisement banner is being displayed to a user accessing a web site and

wherein a statistical report is being produced by a third party, as understood by those

skilled in the art. Finally, it is inherent in the Wexler's reference that all these identifiers

or indicia will be stored in a database (See abstract; col. 5: 24 to col. 6: 19; claim 3).

Once a user is on-line, i.e., connected to the Internet through an Internet Service

Provider (ISP), the link 11 to the Web site 5 of fig. 1 is established by "entering" the

address, i.e., the uniform resource locator (URL), of the Web site 5 into the Web browser

3. Once the link 11 is established, the Web browser 3 sends a download <u>request</u> signal

11a to the Web site 5. In response, the Web site 5 downloads information, indicated by

the reference numeral 11b, to the user's Web browser 3. The downloaded information

includes a Web page 7 having a banner 9. **The banner 9 is an area of the Web page 7**

that can be used to display logos, etc., that will hopefully entice a user reading the

banner to obtain further information pertaining to the banner (col. 3: 46-58).

See col. 1: 21-30; col. 2: 38-61; col. 3: 65 to col. 5: 23.

As per claims 1, 2, 15 and 16, Wexler does not expressly disclose providing

requested information to a user via the user's e-mail address.

However, it is common practice in the art to deliver or transmit requested

information, including discount coupon, to a user who directly or indirectly requests

the information, wherein the requested information is either displayed in real-time on

the user's screen, e-mailed to the user via the user's recorded e-mail address or even

faxed to the user (See WO 97/23838). "Official Notice".

Therefore, an ordinary skilled artisan would have been motivated at the time

of the invention to incorporate the above disclosure ("Official Notice") into the

Wexler's system so as provide, upon receiving a signal, requested information (more

details), related to a presented advertisement or promotion, to a user via the user's e-

mail, thereby providing the requested (more) information, related to a featured or

presented promotion or ad, in substantially real-time to the user instead of mailing

the information, while enticing the user to acquire or purchase a product/service

presented in the ad

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under
section 122(b), by another filed in the United States before the invention by the
applicant for patent or (2) a patent granted on an application for patent by another
filed in the United States before the invention by the applicant for patent, except
that an international application filed under the treaty defined in section 351(a)
shall have the effects for purposes of this subsection of an application filed in the
United States only if the international application designated the United States
and was published under Article 21(2) of such treaty in the English language.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by

Scroggie, USP 6,014,634.

As per claims 1-20, Scroggie teaches a system and method for delivering

purchasing incentives and a variety of other retail shopping aids through a computer

network, such as by E-mail over the Internet or the World Wide Web. Customers

(10) of retail stores can establish a bidirectional communication link with the system,

log in (16) to the system, and then elect to browse among available purchasing

incentive offers (18, 22), or elect to explore other shopping aids, such as a shopping

list generator (26), a recipe center (30), or simply elect to claim a product rebate or to

receive product information. **If the customer elects to have, subsequent to being**

exposed to a product promotion or advertisement, requested product

information or rebate information, related to the featured product promotion

or presented advertisement, delivered to him by mail or e-mail, only minimal

customer identification is required. For <u>purchase</u> incentives redeemable at retail

stores, the customer must provide identification information and must also designate

a retailer (12) at which the <u>purchasing</u> incentive can be exercised. For receipt of

focused incentives based the customer's past shopping behavior, the customer must

also supply a unique customer id., such as a check cashing card number or credit

card number, used for in-store <u>purchases</u>. For delivery of a product sample, the

customer's name and address must be supplied. The system merges this customer-

supplied information (270) with other <u>purchase</u> incentive data (272) and creates a

printable graphical image of the <u>purchasing</u> incentive (282) for transmission to the

customer. In an alternate embodiment of the invention, the <u>purchase</u> incentive is not

transmitted directly to the customer. Instead, the terms of the incentive are

transmitted electronically to the retail store (310) designated by the customer, who

receives either a token (316) to present at the store or an advisory message. In yet

another embodiment of the invention, incentives may be targeted to specific

consumers based on a consumer <u>purchase</u> history (502), and transmitted to

consumers' computers (510) using <u>electronic mail</u> addresses stored in a consumer

database (506), or using a "personal page" in the computer network, established for

each consenting consumer (See abstract; figs. 1-18; col. 1: 47 to col. 5: 12; col. 6:

39-54).

Scroggie further discloses that in the cooperative site on which the present system

is implemented, all the <u>advertised</u> incentives, whether coming from retailers or

manufacturers, can be timed to comply with the <u>advertising</u> cycle of the local retail region (col. 4: 40-44).

Here, an offer browser contains advertised offers (promotions) submitted by product manufacturers. As shown in FIG. 5, the offer browser is entered from the main menu, via block 140, and opens with an individual offer page 142. The offer page contains details of an offer, along with a number of control buttons. The user may select prior or next offers or promotions, as indicated in block 144, or may select a coupon based on the offer, as indicated in block 145, the coupon being added to the session record as indicated in block 147 before a final list is being generated **and, in the end, the coupon (discount) or requested information, related to the offer or promotion, is transmitted to the user via e-mail**. Each offer may have a number of sub-offer options associated with it (col. 8: 6-55; col. 11: 63 to col. 12: 10).

The final list generation phase, comprising recipes, requested coupon discounts (requested information), related to the offers or promotions, also contains <u>hyperlinks</u> to sites established by individual manufacturers' and retailers' sites where the customers can receive more information about a product or service featured in an offer, promotion or advertisement. Finally, the system displays a "thank you" message and ends the session, as indicated in block 262 (col. 10: 4-8).

Additionally, at least one focused incentive is transmitted to the customer, as indicated in block 416 of fig. 14, in the form of an Internet message, for retrieval when the customer next accesses the Web site or checks for <u>electronic mail (E-mail)</u>. The incentive message informs the customer that one or more specific offers are available and

may be received at the checkout stand when the prerequisite products are <u>purchased</u>.

Alternatively, a paper coupon may be transmitted to the customer's computer site and

printed for later presentation in the store (delivering a targeted or focused incentive or

discount coupon or more information, indirectly requested by a customer, to the customer

via e-mail-Col. 12: 55-64; col. 13: 7-56).

Finally, a consumer database 506 of fig.15, maintained by a network

administrator, receives data primarily from the network or system administrator's Web

site, indicated at block 508, which, in turn, receives a consumer's <u>E-mail</u> address from

each consumer's computer, indicated at 510. The consumer database 506 may also

receive E-mail addresses from independent consumer E-mail address lists, indicated in

block 512 (col. 13: 27-30).

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

USP 6,029,141 to Bezos discloses a referral-based system that enables an

individual or other business entity or associate or publisher, via a web site 100, to

market products to customers, in return for a fee or commission or compensation, from a

merchant's or advertiser's web site 106 having at least one web page to display

information and connected to the Internet 104 of fig. 1. Upon visiting or accessing the

associate's or publisher's web site 100, a customer or user, via customer's PC 108, views

an advertisement (user's action) for a particular product or service displayed on the

publisher's web site 100. Furthermore, upon clicking (user's action) on a hyperlink or

referral link displayed on the publisher's or associate's web site 100, the customer can be

transported to the advertiser's or merchant's web site 106 where he can receive more

information about the advertised product or other products and/or even purchase the

advertised product or other products. When the customer selects the referral link, the

customer's computer 108 transmits unique IDs or tags of the selected or advertised

product and of the associate or publisher to the merchant's or advertiser web site 106,

thereby allowing the merchant or advertiser to identify the advertised product and the

referring publisher or associate of the referring web site 100. Subsequently, if the

customer purchases the advertised product (and/or other products) from the merchant's or

advertiser's web site 106, a commission is automatically credited to an account of the

referring publisher or associate, using an appropriate electronic payment method, which

indicates (notifies) to the publisher of the referring web site 100 that the advertised

product was indeed purchased by the visiting customer (See abstract; fig. 1; col. 1: 62 to

col. 2: 17; col. 3: 33-41; col. 12: 42-51; col. 16: 1-2). Moreover, the customer can receive

a special discount or pricing incentive (privilege), based on a particular business

relationship between the publisher or associate of the referring web site 100 and the

merchant or advertiser of web site 106, in an effort to encourage the customer to purchase

at least the advertised product (performing designated action) at the merchant's or

advertiser's web site 106 wherein the special discount is applied to the customer's

purchase during a current transaction, as known in the art (col. 14: 48-51). Additionally, a

software module, associated with the merchant's or advertiser's web site 106,

automatically generates and transmits, via e-mail, associate or publisher feedback reports

to respective associates or publishers of web sites 100, based on information stored by the

advertiser's web site 106 (notifying the publisher of the referring web site). The software

can be configured to generate the reports on a daily, weekly, monthly and annual basis.

The information contained within these reports enables or helps the associates or

publishers of referring web sites 100 of fig. 1 to evaluate the effectiveness of their web

sites 100 on a per-product basis (fig. 1: col. 16: 11-41; col. 18: 23 to col. 19: 23).

US Patent 5, 937, 390 to Hyodo discloses a system for counting the number of

hit rate associated with the distribution of an advertisement.

USP 5,937,392A to Alberts discloses an Internet advertising system having a

database, a controller, and an ad server operating as part of a web server. The

database has advertising campaign information, including identification

information and <u>frequency</u> information for how often the ad is to be served. The ad

server uses the campaign information from the database to control the relative

ratios of serving ads, the distribution of ads throughout the day, and any triggering

mechanisms for controlling what ads are served.

USP 6,009,409A to Adler discloses a system and method for scheduling and

controlling delivery of advertising in a communication network and a

communications network and remote computer program employing the system or

the method. The system includes: (1) a time allocation controller that allocates time

available in a particular advertising region in a display device of a remote computer

between at least two advertisements as a function of one of a desired user frequency,

a desired time frequency, or a desired geometry, for each of the at least two

advertisements and (2) data communication controller, coupled to the time

allocation controller, that delivers the at least two advertisements to said remote

computer for display in the advertising region according to the allocating of the time

(See abstract; col. 7: 66 to col. 14: 67).

Any inquiry concerning this communication from the Examiner should be

directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The

aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM

EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

04/02/07

                                                             Jean D. Janvier

JDJ   Patent Examiner

                                                             Art Unit 3622

JEAN D. JANVIER
PRIMARY EXAMINER